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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,026	10/23/2003	Sundaram Ravikumar	RAV-010	6454

36822 7590 04/27/2007
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EXAMINER

KOTINI, PAVITRA

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

ED

Office Action Summary	Application No.		Applicant(s)	
	10/692,026		RAVIKUMAR, SUNDARAM	
	Examiner		Art Unit	
	Pavitra Kotini		3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/5/07.

Applicant's election with traverse of Group III, claims 17-19, in the reply filed on 2/5/07 is acknowledged. The traversal is on the ground(s) that the inventions must be independent *and* distinct. This is not found persuasive because as set forth in MPEP 806 and 806.01, the restriction requires analyzing the claims to be independent *or* distinct. The requirement is still deemed proper and is therefore made FINAL.

The Examiner has carefully considered the Applicants arguments against the restriction requirement between group I and II and has deemed that the inventions of group I and II are still related as combination and subcombination. Although the Applicant has amended claims 7-11 (group II) and removed the utility of occluding a blood vessel, group II is a combination of the insertion device and the plug that does not necessarily require the particulars of the subcombination (plug) such as spring based prongs. The plug has utility by itself or with another type of insertion device that places the plug anywhere in the vascular system or even in the heart to occlude a shunt. Even in light of the amendment, Group I and II are distinct inventions. Therefore, after reconsideration, the restriction requirement between groups I and II is deemed proper.

Regarding the restriction requirement between the apparatus and method claims, the Examiner has deemed the restriction requirement to be proper. Even in light of the amendment, the process of occluding a uterine tube can be practiced with another materially different product such as a hysteroscope or a balloon catheter. Similarly, the product as claimed can be used in a materially different process such as for deploying a closure device to occlude a shunt in the heart. Therefore, the restriction requirement between the apparatus and method claims is also proper. As a result, claims 17-19, as elected with traverse, will be examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (US-4869268). Yoon discloses a method of occluding a uterine tube comprising:

Regarding **claim 17**, a plug body comprising a tapered outer surface and a large diameter section having a diameter greater than the interior diameter of the uterine tube portion (220), said plug body having a central axis; substantially aligning said central axis of said plug body with a longitudinal axis of the uterine tube portion (fig. 47); applying an axial force to insert said plug body into said uterine tube portion (col.9, lines

7-25); and removing said axial force such that a wall section of uterine tube portion grasps onto said plug body to hold it in place (col.9, lines 7-25).

Yoon does not disclose specific diameter of the plug. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the plug to include a diameter between 1.0mm and 2.5mm. Such a modification would have involved a mere change in the size of the component. Furthermore, it is old and well known in the art that an uterine plug is customized to ensure that the passageway will be occluded. Therefore, the size of the plug will depend upon the size of the patient's uterine tubes. Please see UK patent by Haeri (GB-2211095) which state the diameter of an uterine plug to be between 2mm to 11mm.

Regarding **claim 18**, the axial force is applied with an insertion device having means to attach said plug body to the insertion device (fig. 44).

Regarding **claim 19**, the insertion device comprises a needle (228, col.9, lines 25-29), a tubular needle guard (14) surrounding the needle, the tubular needle guard fitting into a pilot hole of the plug body (fig. 43), and a spring-biased lever (72, fig. 7) operable to retract the needle into the tubular needle guard to release an attached plug body (col.5, lines 45-55; when members 68 and 70 are moved apart, member 16 releases plug 220 off of the distal end 20), the method further comprising the step of operating said lever to release said plug body (col.9, lines 19-24).

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pavitra Kotini whose telephone number is 571-272-0624. The examiner can normally be reached on M-F 8:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.Kotini
AU 3731


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
